

PATENT
Serial No.: 09/690,199
Docket No. 28150.7
Customer No. 000027683

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 3-5, 8, 10-12, 15 and 17-19 have been amended. Claims 1-21 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims. Accordingly, no new matter has been entered.

Information Disclosure Statement

In the Information Disclosure Statement mailed by Applicant to the USPTO on September 10, 2002 ("IDS"), the Examiner neither initialed nor deleted the following cited reference. Accordingly, in the IDS, Applicant respectfully requests that the Examiner please initial such reference.

U.S. Provisional application No. 60/215,683, filed on June 30, 2000, having Kevin McCurdy as inventor, and entitled "Electronic Magazine System".

Objections

Claims 5, 12 and 19 have been amended to overcome the Office Action's objections thereto.

Rejection of the claims

The Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,484,198 ("Milovanovic").

As amended, claim 1 recites:

1. A method performed by a computer system, comprising:
storing a version of a mass-produced printed paper; and
forming a reference within the version, wherein the reference is a hyperlink ~~being~~ associated with an operation and at least a portion of the version, wherein the version is being displayable on a display device as a likeness of the paper, and wherein the portion is being selectable to cause performance of the operation.

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As amended, claim 8 recites:

8. A system, comprising:
a computing device for:

storing a version of a mass-produced printed paper; and
forming a reference within the version, wherein the reference is a hyperlink
being associated with an operation and at least a portion of the version,
wherein the version is being displayable on a display device as a
likeness of the paper, and wherein the portion is being selectable to
cause performance of the operation.

As amended, claim 15 recites:

15. (Currently amended) A computer program product, comprising:
a computer program processable by a computer system for causing the computer
system to:

store a version of a mass-produced printed paper; and
form a reference within the version, wherein the reference is a hyperlink being
associated with an operation and at least a portion of the version,
wherein the version is being displayable on a display device as a
likeness of the paper, and wherein the portion is being selectable to
cause performance of the operation; and

an apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

*"[t]o anticipate a claim, the reference must teach every
element of the claim...."*

Therefore, to sustain a rejection of claim 1, Milovanovic must contain all of the
above-recited elements in claim 1. However, Milovanovic fails to teach the combination of
elements in amended claim 1. Accordingly, Milovanovic does not support a rejection of
amended claim 1 under 35 U.S.C. § 102(e).

In relation to amended claims 8 and 15, Milovanovic is likewise defective in
supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of
factually supporting any *prima facie* conclusion of obviousness. If the examiner does not
produce a *prima facie* case, the applicant is under no obligation to submit evidence of
nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time
and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the
invention was unknown and just before it was made...The examiner must put aside

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knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to amended claim 1, Milovanovic is defective in establishing a *prima facie* case of obviousness. For example, as between Milovanovic and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 1. In fact, Milovanovic teaches away from such a combination.

The Office Action cites Milovanovic's paragraph at col. 2, lines 11-24, which immediately follows its paragraph at col. 1, line 65-col. 2, line 10. Nevertheless, in those paragraphs, Milovanovic describes a "reference" in electronic tag information (e.g., bar code) that is attached by a publisher directly on a portion of the published item, before distribution to subscribers. After the subscriber receives the published item, the subscriber swipes or enters the electronic tag information into a sensing device. From the sensing device, a computing means receives the electronic tag information and formats a request that is transmitted to the publisher over a network. The request is received and processed by the publisher who, in turn, formats and pushes (to the user) a response message that contains a pointer to a network site (e.g., a URL).

Clearly, therefore, Milovanovic teaches away from amended claim 1. In amended claim 1, a reference is formed within a version of a mass-produced printed paper, wherein the reference is a hyperlink. In contrast, Milovanovic's "reference" is not a hyperlink. For example, if Milovanovic's "reference" were a hyperlink (in the electronic tag information that is attached by the publisher directly on a portion of the published item, before distribution to subscribers), then Milovanovic's publisher would not be compelled to format and push (to the user) a subsequent response message containing such pointer.

Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a *prima facie* case of obviousness has not been met.

In relation to amended claims 8 and 15, Milovanovic is likewise defective in establishing a *prima facie* case of obviousness.

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Thus, a rejection of amended claims 1, 8 and 15 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

Dependent claims 2-7 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 9-14 depend from and further limit claim 8 and therefore are allowable.

Dependent claims 16-21 depend from and further limit claim 15 and therefore are allowable.

An early formal notice of allowance of claims 1-21 is requested.

A \$55.00 fee (small entity) is due for a 1-month extension of response, but otherwise no additional fee is believed due. Nevertheless, to the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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